

## **REMARKS**

Claims 12, 13, 17, 20, 22, 24, 49 and 50 are pending. Claims 12 and 24 have been amended. Claims 1 to 11, 14 to 16, 18, 19, 21, 23, 25, 26, and 28 to 48 are cancelled. New Claims 49 and 50 have been added.

The Office Action stated that the objection of the specification and the 35 U.S.C. 112, second paragraph, rejection of claim 12 has been withdrawn due to applicants' amendment on 11/1/04.

The Office Action stated that the 35 U.S.C. 103(a) rejection over Schlaeppli et al. of Claim 12 to 14, 20 and 27 has been withdrawn due to applicants' amendment on 11/1/04.

The Office Action stated that the 35 U.S.C. 103(a) rejection over Schlaeppli et al. in view of Olivieri et al. of Claims 16, 17 and 21 to 26 has been withdrawn due to applicants' amendment on 11/1/04.

The Office Action stated that the 35 U.S.C. 103(a) rejection over Olivieri et al. in view of Schlaeppli et al. of Claim 12 to 14, 16, 17 and 20 to 27 has been withdrawn due to applicants' amendment on 11/1/04.

Claims 12 to 17, 20 to 24 and 27 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicants' traverse this rejection.

The Office Action stated that the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants traverse this

statement. The Examiner based this rejection only on the first paragraph of Section 112, and quoted that part of the patent statute on page 2 of the Office Action as follows:

“The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is mostly nearly connected, to make and use the same....”

Nowhere does the first paragraph of Section 112 say “in such a way as to reasonably convey” or “the inventor(s), at the time the application was filed, had possession of the claimed invention”. The Examiner’s statement is not even related to the requirement of the first paragraph of Section 112. The Examiner’s statement basically asserts that the specification does not reasonably convey to one skilled in that the applicant possessed the invention at the time the application was filed. That has nothing to do with Section 112, first paragraph, that which is required by the first paragraph of Section 112 is that the written description enables one skilled in the art to make and use the invention. The Examiner has not used the requirements of the first paragraphs of Section 112 so this rejection is defective on its facts.

The Examiner has not factually shown, or even alleged, in the record that applicants’ specification does not have a written description that is in such full, clear, concise and exact terms as to enable one skilled in the art to make and use the invention. This fact alone shows that this rejection is defective and

should be withdrawn (at least until the requirements of Section 112, first paragraph, are alleged and factually established in the record).

Furthermore, using the Examiner's standard that is not found in the patent statute, the Examiner has not factually established in the record that applicants' specification does not reasonably convey (at the time the application was filed) that the applicants possessed the invention. The Examiner has not carried his burden of proof.

The Office Action stated that the new matter is "there being no other layer in contact with the plastic film during the cutting of the at least one line of perforations". Applicants traverse this statement. Figure 1 shows no layer on the lower side of the layer 14. Also Figure 1 shows adhesive layer 16 directly on the upper side of layer 14 with no other layer between adhesive layer 16 and layer 14. Perforation 18 in layer 14 does not extend into adhesive layer 16. This factually shows that adhesive layer 16 (and no other layer) was on the side of layer 14 when perforations 18 were cut in layer 14. Page 2, lines 29 and 30, of the specification states:

"The cutting may take place before or after coating the film with an adhesive layer." [Emphasis supplied]

See also original Claims 3 and 4. Page 3, line 26 to 30, of the specification, in describing the production of the packaging film of Figure 1 states:

"The production of the packaging film shown in figure 1 is such that first the inner layer 14 is available in strip form and lines of perforations 18 are cut into it using a cutting device. The pre-cut inner layer 14 is then

joined to the outer layer 12 to make the packaging film 10. Thereby, the layer of adhesive 16 may if desired already be presented on the inner layer 14 before the cutting is performed.” [Emphasis supplied]

Page 3, lines 20 to 24, states:

“A packaging film 10 shown in figure 1 has an outer layer 12 of e.g. polyethyleneterephthalate (PET) and a layer 14 e.g. of polyethylene (PE) which later in the packaging faces the contents. The inner layer 14 is bonded to the outer layer 12 e.g. via an adhesive layer 16 e.g. of polyurethane (PU) basis. In an alternative version the inner layer 14 is joined to the outer layer 12 by extrusion.”

The above information shows the process claim phrase “there being no other in contact with the plastic film during the cutting of at least one line of perforations” is not new matter and is fully supported by the disclosure in the specification including the original claims, and in the drawings.

The initial burden of proof is upon the Examiner to factually establish that the subject process claim phrase is new matter, and he has not carried his burden of proof. The mere assertion that new matter is involved is insufficient. Applicants have factually shown that the subject process claim phrase is not new matter. The initial burden of proof is also upon the Examiner to factually establish that the subject process claim phrase is not disclosed in the specification, and he has not carried his burden of proof. His mere assertion is insufficient. Applicants have factually shown that the subject process claim phrase is factually disclosed and supported in the specification.

The specification has been amended to insert the factually disclosed and supported subject process claim phrase in its exact language into the specification on page 2, line 34. Since the applicants' have shown that this rejection is incorrect, entry of the subject process claim phrase into the specification is requested.

The Office Action stated that the specification does not disclose that there is no other layer in contact with the plastic film during the cutting of the at least one line of the perforations.

Application's traverse this statement and have factually shown above that it is incorrect.

The Office Action stated that applicants simply amended the claims to over the prior art of Olivieri et al. This statement is meaningless under the patent law. The subject process claim phrase (limitation) is fully disclosed and supported by the specification (and the original claims and drawings). The specification includes the original claims 35 U.S.C. 112, second paragraph, and 37 C.F.R. 1.75(a).

This rejection should be withdrawn.

While on the subject of the above rejection, the Examiner notes have been inconsistent. The Examiner cannot correctly take a position in one rejection and then an opposite position in the same matter in another rejection.

In the anticipation rejection in the Office Action, the Examiner states, regarding the Niwa patent reference, that:

“..., there being no other layer in contact with the plastic film during the cutting of the at least one line of perforations (col. 3 lines 15-25), ....”

The cited portion of Niwa states:

“Then, one of the plastic films 4 of the one of the rolls 3 is subjected to slit formation so as to form the intermittent slits 7 extending in the feeding direction with the unslitted portions 6 between the intermittent slits at predetermined interval by means of the cutter device 5 positioned in front of the roll 3 with respect to the feeding direction.” [Emphasis supplied]  
[Col. 3, lines 15 to 22]

Using the approach that the Examiner used in the Section 112 rejection, then this portion of Niwa does not disclose that no other layer is in contact with the plastic layer (a film 3) during cutting of the perforations. Applicants' specification states:

“The production of the packaging film shown in figure 1 is such that first the inner layer 14 is available in strip form and lines of perforations 18 are cut into it using a cutting device. [Emphasis supplied] [ Page 3, lines 26 to 28]

Based upon the Examiner's contention regarding Niwa in the anticipation rejection, the above-quoted portion of applicants' specification is disclosure that no other layer is in contact with the plastic layer during cutting of the perforations.

Again, the Examiner must be consistent.

Claims 12, 13, 17 and 27 have been rejected under 35 U.S.C. 102(b) as being anticipated by Niwa (European Published Patent Application 0468619).

Applicants traverse this rejection.

The Office Action stated that Niwa discloses a process for preparing a multilayer packaging (col. 1, lines 1 to 3), comprising cutting at least one line of perforations completely through a plastic film consisting of a single plastic film (col. 3, lines 15 to 20), that is to be a precut, surface plastic layer of the multilayer packaging film (Figure 1, number 4), there being no other layer in contact with the plastic film during the cutting of the at least one line of perforations (Col. 3, lines 15 to 25), each of the at least one line of perforations extending from edge to edge of the plastic film (Figure 3, number 7), and joining the precut plastic layer with at least one other layer to form the multilayer packaging film (col. 3 lines 22 to 25), and providing a notch in one edge of the multilayer packing film in the region of the perforations for initiating tearing along the tear line (col. 3, lines 35 to 48), the at least one line of perforations serve as an aid for alignment of the tear line propagating in the multilayer packaging film upon tearing open the packaging (col. 3 lines 44 to 48), the packaging being easy to open by means of the tear line and the notch (col. 3, lines 35 to 38). While applicants disagree with this statement, the subject claims have been amended in manners that avoid anticipation by Niwa.

Amended Claim 12 includes the subject matter of Claim 16, and amended process Claim 17 is dependent upon Claim 12, so neither amended claim is anticipated by Niwa.

Amended Claims 27 requires producing a packaging pouch that has at least one line of perforations on each side of the pouch so amended Claim 27 is not anticipated by Niwa.

New Claim 49 is a combination of amended Claim 27 and the requirement that both of the plastic films have the at least one line of perforations are situated on the inner side of the pouch.

The Office Action stated that Niwa discloses that the precut plastic layer is joined to the last one other layer by means of an adhesive layer to make up the multilayer film (co. 3, lines 22 to 25). This does not cause Niwa to teach or suggest any of the claims.

The Office Action stated that Niwa discloses that wherein two lines of perforations are cut parallel or substantially parallel to each other at a distance apart as guidelines on both sides of a tear which propagates in the packaging film on tearing open (col. 3, lines 50). Applicants disagree that column 3, line 50, of Niwa discloses parallel or substantially parallel lines of perforations. However, reference is made to Figures 2 and 3 of Niwa. Figure 3 of Niwa shows notch 10 below both parallel lines 7 of perforations.

The Office Action stated that Niwa discloses wherein the packaging film is employed for the production of pouch forms of packaging (col. 3, lines 31 to 34). This does not cause anticipation.

This rejection should be withdrawn.

Claims 16, 23 and 24 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Niwa (European Published Patent Application 0468619) in view of Olivieri et al. (U.S. Patent No. 6,427,420). Applicants traverse this rejection as being speculation and mere forbidden hindsight.



The Office Action stated that Niwa discloses the process for preparing a multilayer packaging film for a packaging as described above. Applicants disagree with this statement.

The Office Action stated that Niwa fails to disclose that the notch is situated between the two lines of perforations. Niwa also directs one ordinarily skilled in the art away from locating a notch between two lines of perforations.

Niwa states:

“The easily openable pouch produced by the above described laminated film is shown in Fig. 3. The easily openable pouch 8 includes multi-layer films containing the above described laminated film. In this case, a notch 10 (triangular notch 10 is shown in the illustrated embodiment) is formed at a side heat seal portion 9 of the easily openable pouch 8. A tip portion of the notch 10 is aligned with the slit 7. Alternatively, the notch 10 is positioned slightly lower than the slit 7 as shown in Fig. 3 for facilitating the opening of the pouch. That is, when opening the pouch, a user grips the upper marginal portion of the resultant pouch, and pulls the upper marginal portion upwardly. Therefore, the upward tearing can easily reach the slit portion 7 positioned immediately above the tip end portion of the notch 10, and thereafter, the tearing can be made along the slit 7.” [Emphasis supplied] [Col. 3, lines 31 to 48]

The entire focus of Niwa, regard the notch, is for the notch to be below the lower of the two line of perforations.

The Office Action stated Olivieri et al. teaches that the notch is situated between the two lines of perforations (Figure 8a, number 431) for the purpose of tearing the materials forming the pack (col. 8 lines 57 and 58). All of the disclosure of Olivieri et al. has to be considered under Section 103(a). The Examiner has not factually shown in the record why any disclosure of Olivieri et al. would be excluded in the search for applicants' claimed invention.

The C.A.F.C. in *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 USPQ2d 1468, (1988), stated:

"Helena cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention. See, e.g., Azko N. V. v. United States Int'l Trade Comm'n, 808 F.2d 1471, 1481, 1 USPQ2d 1241, 1246, (Fed. Cir. 1986), cert. denied, 107 S.Ct. 2490 (1987). Helena has the burden to show some teaching or suggestion in the reference to support their use in the particular claimed combination. Uniroyal Inc, 837 F2d at 1051, 5 USPQ2d at 1438-39. A holding that combination claims are invalid based merely upon finding similar elements of separate prior art patents would be 'contrary to statute and would defeat the congressional purpose in enacting Title 35.' Panduit Corp., 810 F.2d at 1577, 1 USPQ2d at 1605." [Page 1475] [Emphasis disclosed]

Olivier et al. only discloses forming perforations in a lower plastic layer (or lower plastic layers) of an already formed multilayer film after the multilayer film has been formed. Therefore, Olivier et al. directs away from applicants' claimed invention.

Furthermore, the combination of Niwa and Olivieri et al. would result in the cutting of lines of perforations in a lower plastic layer(s) of an already formed multilayer film. The Examiner has not provided any reasons or facts in the record why one ordinarily skilled in the art in search for applicants' claimed invention, would ignore the subject limitation / feature that is a core part of the Olivieri et al. invention.

Olivieri et al. states:

"Method for the manufacture of a pack, particularly intended for undergoing preservation treatment, from at least one film (10), comprising the two plastic layers, an upper (11) and a lower (12), which form the outer and inner faces of the said pack, and a light-metal central layer (13) sandwiched between the said upper (11) and lower (12) layers, characterized in that, prior to the operations to make the said pack, a laser beam is applied solely to the lower layer (12) of the said film (10), the said lower layer forming the inner face of the said pack, in order to produce, virtually in the entire thickness of the said lower layer (12), at least one perforation (14) forming at least one precut line." [Emphasis supplied]  
[Claim 1, lines 1 to 13]

All of the teaching/disclosures of a prior art rejection references must be considered and cannot be ignored without compelling facts and/or reasons in the record. There are no such compelling facts and/or reasons in the record.

Since Olivieri et al. cuts a lower layer after the multi-layer film has been formed, there are conflicting and contradictory teachings in the record. The

Examiner has not factually established in the record why one ordinarily skilled in the art would not be drawn to the cutting of a lower layer of the multi-layer film, which makes applicants' claimed invention unobvious.

Page 2100-127 of the M.P.E.P. [Section 2141.03, (Rev. 2, May 2004)] states:

"PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS"

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.

*W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) ...."

Schlaepi et al. (European Published Patent Application 0596747) is of record and is even currently used in another rejection in the Office Action.

The invention of Schlaepi et al. does not include or use a notch. In fact, Schlaepi et al. teaches away from the use of a notch because of problems associated with the use of notches. Schlaepi et al. set out, in its prior art section, the problem with the prior art use of notches which Schlaepi et al. sought to avoid by its invention. In view of the negative teaching of Schlaepi, et al. one ordinarily skilled in the art would avoid the use of a notch in the search for applicants' claimed invention.

The Office Action stated that, therefore, it would have been obvious to one having ordinary skill in the art at the time applicants' invention was made to provide Niwa with the notch that is situated between the two lines of perforations

in order to tear the materials forming the pack (col. 8, lines 57 and 58) as taught by Olivieri et al. Applicants traverse this statement as being mere forbidden hindsight. The Examiner has not factually provided in the record the motivation to combine Niwa and Olivieri et al. If such references are combined, the result is not applicants' claimed invention. Schlaeppi et al. directs away from the use of a notch.

This rejection should be withdrawn.

Claims 20 to 22 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Niwa (European Published Patent Application 0468619) in view Schlaeppi et al. (European Published Patent Application 0596747). Applicants traverse this rejection.

The Office Action stated: Niwa discloses the process for preparing a multilayer packaging film for a packaging as described above; that Niwa fail to disclose wherein the precut plastic layer is joined to the at least one other layer by means of extrusion to make up the multi-layered film; and that Schlaeppi et al. teaches that it is well known in the art to secure the other layer to the inner layer by an adhesive or by other lamination or extrusion coating techniques (col. 4, lines 19 to 21). The combination of Niwa and Schlaeppi et al. does not result in applicants' claimed invention.

The Schlaeppi et al. invention did not use a notch and directed away from the use of a notch. Schlaeppi et al. set out, in its prior art section, the prior art problems that the Schlaeppi et al. invention was made to avoid and/or overcome.

Schlaeppi et al. clearly directs one ordinarily skilled in the art away from the use of a notch and the problems that it attributes to notches.

Therefore, the combination of Niwa and Schlaeppi et al. would be the absence of a notch. The Examiner has not factually in the record why one ordinarily skilled in the art would ignore the negative teaching of Schlaeppi et al. All of the present claims require a notch.

It is impermissible within the framework of Section 103(a) to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Wesslau, 147 USPQ 391, 393, (C.C.P.A. 1965).

The Office Action stated that, therefore, it would have been obvious to one having ordinary skill in the art at the time applicants' invention was made to provide Niwa with the precut plastic layer that is joined to the at least one other layer by means of extrusion to make up the multilayered film as it is notoriously well known in the art to secure the other layer to the inner layer by an adhesive or by other lamination or extrusion coating techniques (col. 4, lines 19 to 21) as taught by Schlaeppi et al. Applicants traverse this statement as being forbidden hindsight. Schlaeppi et al. teaches not to use a notch. The result of the combination of Niwa and Schlaeppi et al. is not applicants' claimed invention.

Olivieri et al. is of record and is even currently used in another rejection in the Office Action.

Olivieri et al. discloses cutting the line(s) of perforations in the inner layer of the already formed multi-layer film. This directs one ordinarily skilled in the art away from applicants' claimed invention.

This rejection should be withdrawn.

Amended Claim 27 is drawn to the production of pouch packages that have at least one line of perforations on both sides thereof. Applicants use their multi-layer film to prepare both sides of their pouch packages. See page 3, lines 1 to 3, and page 3, line 32, to page 4, line 4. Niwa only uses lines of perforation on one side of its pouch. See column 3, lines 12 to 18.

New Claim 49 is Claim 27 with the requirement that the inner faces of the two sides of the pouch have the line(s) of perforations. Page 3, lines 1 to 3, states:

“In the case of packaging made from the packaging film e.g. a pouch-type form of packaging, the film with the perforations in it is preferably situated on the inside of the packaging.”

Niwa does not disclose use of line(s) of perforations on the inner side of the pouch. See Figure 3, and column 3, line 58, to column 4, line 16.

Reconsideration, reexamination and allowance of the claims are  
requested.

Respectfully submitted,

6/1/05  
Date

Virgil H. Marsh  
Virgil H. Marsh  
Reg. No. 23,083

Fisher, Christen & Sabol  
1725 K St., NW  
Suite 1108  
Washington, DC 20006  
Tel.: 202-659-2000  
Fax: 202-659-2015

